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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,394	01/05/2004	Robert B. Tepperman	205236-9007	2644

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EXAMINER

TOMPKINS, ALISSA JILL

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,394

Applicant(s)

TEPPERMAN, ROBERT B.

Examiner

Alissa J. Tompkins

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pouch of claim 3, the closure device of claim 9, the perforations of claim 10, and the encircling perforation of claims 13 and 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 3765

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 4 and 6 contain the trademark/trade name Tyvek. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe protective material and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lathan (U.S. 5,586,339). Lathan discloses an outer protective garment 10 comprising a torso covering assembly 12 having two-arm covering assemblies 14 and a pants assembly 22 having two leg covering assemblies 28. The torso covering assembly has head 16, waist 43, and wrist openings 18, which include elastic material to provide the wearer with a snugly fitted garment (Column 5, 45-63). The torso covering assembly is capable of being worn as a jacket. The pants assembly can be connected to the torso assembly and includes an elastic ankle-encompassing assembly 24 (Column 5, 64-67-Column 6, 1-4)(Figures 1 and 2). A rip cord 54 includes a grasp ring 55 that is used to close and/or remove the garment (Column 6, 47-58)(Figures 5 and 6). The garment is made of a thin thermoplastic material made with polyethylene (Column 7, 2-3). The thin material allows the garment to be capable of being folded or rolled up for insertion into a pouch/fanny pack.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6-12, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lathan. Lathan discloses the invention substantially as applied in

Art Unit: 3765

claims 1, 2, and 5 above. However, Lathan is missing a garment that is perforated and is made out of Tyvek. Although Lathan's garment does not show perforations for the removal means 54, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use perforations in combination with the rip cord disclosed in order to help facilitate the removal function and to provide a comfortable garment that is fast and easy for the wearer to take off. Lathan's garment is made out of a thin thermoplastic material made with polyethylene. Tyvek is known to be used as a protective material and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyethylene in place of Tyvek in order to provide a garment having protective qualities.

As for claims 16-20, although Lathan does not state the method for using the disposable outerwear, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the outerwear as claimed in order to provide disposable outerwear to protect athletes during extended length activities.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lathan in view of Davis (U.S. 6,405,377). Lathan discloses the invention substantially as applied in claims 1, 2, 4-12, and 15-20 above. However, Lathan is missing a pouch that is capable of storing the disposable jacket and/or pants. Davis shows a convertible jacket 10 that is convertible into a duffle bag 16. The jacket comprises a pocket 18 formed between outer shell 20 and inner shell 22 of the inside back portion 24 of the jacket (Column 2, 10-13). The jacket is capable of being folded into the interior 30 of the duffle bag for storage purposes (Column 2, 27-28). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to use the teachings of Davis to modify Lathan in order to provide a jacket that can be converted into a pouch/bag to be used for storing the jacket or other miscellaneous items.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lathan in view of Tisdale et al. (U.S. 5,774,892). Lathan discloses the invention substantially as applied in claims 1-12 and 15-20 above. However, Lathan is missing perforations that encircle the arms and legs providing a variable length jacket and a short-legged pant. Tisdale shows convertible clothing comprising a shirt and pants. The shirt 2 has detachable lower sleeve portions 4 allowing the long sleeved shirt to be converted to a short sleeve shirt. The pants 6 have detachable lower leg portions 8 allowing the pants to be converted into shorts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Tisdale to modify Lathan in order to provide convertible clothing having removably attached sleeves and leg portions whereby the attachment means are easily concealed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goldsby (U.S. 5,182,812) shows a layered reducing garment. Steinman (U.S. 2002/0108163), Toth (U.S. 4,408,357), Pontes (U.S. 6,412,115), and Schulson (U.S. 2005/0059945) show disposable garments. Carman (U.S. 5,794,263) shows a jacket having a pouch.

Art Unit: 3765


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa J. Tompkins whose telephone number is 571-272- 3425. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 571-272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alissa Tompkins
Patent Examiner
Art Unit 3765
June 12, 2006

AJT


SHAUN R. HURLEY
PRIMARY EXAMINER